

ESTTA Tracking number: **ESTTA628157**

Filing date: **09/19/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85635705
Applicant	Boehringer Ingelheim Pharmaceuticals, Inc.
Applied for Mark	CSC CLINICAL SCIENCE CONSULTANTS
Correspondence Address	SCOTT J MAJOR MILLEN WHITE ZELANO & BRANIGAN PC 2200 CLARENDON BLVD , SUITE 1400 ARLINGTON, VA 22201-3379 UNITED STATES docketing@mwzb.com, major@mwzb.com, culver@mwzb.com
Submission	Applicants Request for Remand and Amendment
Attachments	REQUEST FOR REMAND.pdf(580750 bytes)
Filer's Name	Scott J. Major
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Signature	/Scott J. Major/
Date	09/19/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re the Application of

Boehringer Ingelheim Pharmaceuticals, Inc.

Application No.: 85635705

Filed: May 25, 2012

Mark: CSC CLINICAL SCIENCE CONSULTANTS & Design

**APPLICANT'S REQUEST FOR
REMAND TO EXAMINING ATTORNEY**

The referenced appeal has been suspended pending disposition of Cancellation No. 92058780. This basis for suspension has been removed, as the proceeding has been dismissed by the Trademark Trial and Appeal Board pursuant to a settlement reached between the parties.

In settling the matter, the parties entered into a consent agreement ("the Consent"; copy attached). The Applicant submits that the Consent should resolve favorably the outstanding issue in this appeal – namely, the refusal to register on the ground of likelihood of confusion with the mark reflected in U.S. Reg. Registration No. 4140675. Accordingly, the Applicant hereby respectfully requests the remand of its application to the Examining Attorney to consider the Consent.

The Applicant submits that it has good cause for requesting remand in that the Consent is an attempt in good faith to resolve the outstanding issue. The Applicant has not delayed in making this request.

For the reasons set forth above, and in the interest of judicial economy, the Applicant submits that this Request for Remand should be granted. The Applicant also requests that the Board suspend action on this appeal pending a decision by the Examiner on remand. If the

Board determines for any reason that the Request for Remand should be denied, the Applicant requests that the Board reactivate the appeal and set the deadline for filing an appeal brief to the date 60 days subsequent to its denial of this request.

Respectfully submitted,

Boehringer Ingelheim Pharmaceuticals, Inc.



Date: September 19, 2014

By: _____
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CONSENT AGREEMENT

Mark: CSC CLINICAL SCIENCE CONSULTANTS & Design

Ser. No.: 85635705

Current Description
of Goods/Services:

printed materials, namely, journals, brochures and newsletters featuring information regarding respiratory, cardio-vascular, oncological, anti-viral, neurological, diabetes and other metabolic diseases and urological conditions and diseases, the management of such conditions and diseases, research regarding such diseases and conditions, and clinical testing and use of pharmaceuticals for treating such conditions and diseases, in International Class 16; and

providing information and consultation services to medical professionals regarding respiratory, cardio-vascular, oncological, anti-viral, neurological, diabetes and other metabolic diseases and urological conditions and diseases, the management of such conditions and diseases, research regarding such diseases and conditions, and clinical testing and use of pharmaceuticals for treating such conditions and diseases, in International Class 44.

Applicant: Boehringer Ingelheim Pharmaceuticals, Inc.

In accordance with the terms of a broader agreement between CSC Scandihealth A/S ("CSC"), the owner U.S. Registration No. 4140675 for the mark CSC CLINICAL SUITE, and Boehringer Ingelheim Pharmaceuticals, Inc. ("BIPI"), CSC hereby consents to the registration and use by BIPI of the above referenced mark for the listed goods and services. CSC and BIPI believe that no consumer confusion as to source is likely to arise from the contemporaneous use and registration of their respective marks in accordance with the terms of this agreement because of factors such as the differences between their respective marks, goods and services and trade channels, and the sophisticated nature of the purchasers for their respective goods and services and the care and deliberation exercised by such purchasers. Should any instances of actual confusion nevertheless occur, the parties agree to undertake such steps as may be determined by

mutual agreement to be necessary and reasonable to prevent the recurrence of such confusion.

Boehringer Ingelheim Pharmaceuticals, Inc.

Dated: August 4, 2014

By: Michael P. Morris

Name: Michael P. Morris

Title: Vice President and Assoc. Gen. Counsel

CSC Scandihealth A/S

Dated: _____

By: _____

Name: _____

Title: _____

mutual agreement to be necessary and reasonable to prevent the recurrence of such confusion.

Boehringer Ingelheim Pharmaceuticals, Inc.

Dated: _____

By: _____

Name: _____

Title: _____

CSC Scandihealth A/S

Dated: August 4, 2014

By: A. S. Nickles, III

Name: A. S. Nickles, III

Title: Senior Principal